

REMARKS

The Office Action dated March 3, 2005 has been received and considered. In this response, claims 1, 15 and 32 have been amended. Support for the amendments to the claims can be found in the specification and figures as originally filed. Reconsideration of the outstanding rejections is respectfully requested in view of the remarks provided below.

Finality of Office Action Premature

The Office Action asserts that the Applicant's amendments necessitated the new ground(s) of rejection presented in the Office Action and, accordingly, the Office Action was made final. *See Office Action*, p. 11. As provided by the M.P.E.P.,

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). . . . Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement . . . , of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final *if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed.* See MPEP § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

M.P.E.P. § 706.07(a)(emphasis added).

In the response to the Office Action mailed October 25, 2004, claim 1 was amended simply to improve its form. Specifically, claim 1 was amended: 1) to change "receiving transport packets" to "receiving one or more transport packets" to reflect that only a single packet may be received; 2) to change "comparing the value" to "comparing a value" to correct the improper antecedent basis; and 3) to change "based upon the first outcome" to "based at least in part on the first outcome," a change which improves the form but does not alter the scope of

the claim. Thus, it will be appreciated that the scope of claim 1 was not materially altered and the amendments were not the basis of the necessity of the newly cited prior art. Thus, claim 1 was not amended for patentability purposes but instead was amended, in effect, for reasons analogous to amendments "expected to be made" in view of 35 U.S.C. § 112. Accordingly, the Applicant respectfully submits that the amendments to claim 1 did not necessitate a new ground of rejection on the part of the Examiner and consequently the finality of the Office Action is premature. Withdrawal of the finality of the Office Action and entry of the amendments to the claims therefore is respectfully requested.

Obviousness Rejection of Claims 1-5, 7-9, 11-19, 22, 23, 29, 31 and 32

At page 2 of the Office Action, claims 1-5, 7-9, 11-19, 22, 23, 29, 31 and 32 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Rim (U.S. Patent No. 5,841,472) in view of ITU-T Recommendation H.222.0 (hereinafter "the ITU-T reference"). This rejection is respectfully traversed.

Rim Fails to Disclose or Suggest Identifying a Transport Packet as Containing Audio Stream Data

Claims 1, from which claims 2-5, 7-9 and 11-14 depend, recites the limitations of identifying a transport packet as containing audio stream data. Claim 32 recites similar limitations. With respect to these limitations, the Examiner cites the passage of Rim at col. 3, lines 25-28 and asserts that "the parser unit [11] must know [sic] what the input data is so that it can output audio, video and PID data." *Office Action*, p. 3. However, it is respectfully submitted that, contrary to the Examiner's assertion, the cited passage of Rim provides no mention of identifying a transport packet as containing audio stream data. Moreover, with respect to the Examiner's conclusion that the parser unit 11 "must know what the input data is," it is submitted that it is not necessary for the parser unit 11 to know whether the transport packet contains audio stream data because the transport packet decoder controller 21a of the parser unit 11 "parses MPEG2 transport packet syntax" and the PES decoder 24 parses "the PES section of the MPEG 2 streams." *See Rim*, col. 4, lines 15-17 and 51-53. One of ordinary skill in the art will appreciate that the identification of audio stream data occurs at the PES level and Rim does not provide any contradiction of this conventional operation. Thus, while the Examiner is correct in that "the parser unit [11] must know what the input data is," its knowledge of whether there is audio stream data present occurs subsequent to parsing the transport streams into PES data and

as Rim does not teach a technique for correlating PES data with the transport packet from which it originated, Rim fails to disclose or suggest the limitations of identifying a transport packet as containing audio stream data as recited by claims 1 and 32.

Rim Fails to Disclose or Suggest Comparing in Response to Identifying the Transport Packet as Containing Audio Data

Claim 1 has been amended to recite the limitations of comparing a value of a first field in the transport packet to a value of a first field register to determine a first outcome *in response to identifying the transport packet as containing audio stream data*. Claim 32 has been similarly amended. The Examiner asserts that the passage of Rim at col. 7, lines 45-67 disclose comparing a value of a first field in the transport packet to a value of a first field register. However, as noted above, Rim fails to disclose or suggest identifying a transport packet as containing audio stream data, so Rim necessarily fails to disclose or suggest the limitations of comparing a value of a first field in the transport packet to a value of a first field register in response to identifying the transport packet as containing audio data. Moreover, even if it is assumed, *arguendo*, that Rim disclosed identifying a transport packet as containing audio stream data, Rim fails to disclose or suggest that the comparison is in response to this identification. The passage of Rim cited by the Examiner discloses that that “the PID field in the transport packet head is compared with the PID in the packet which the user wants . . .” and goes on to describe the various comparisons for the PID fields for video, audio and data packets. *See Rim*, col. 7, lines 45-67. However, this passage does not teach that any of these PID comparisons are in response to identifying the transport packet as containing audio data. Accordingly, Rim fails to disclose or suggest the limitations of comparing a value of a first field in the transport packet to a value of a first field register to determine a first outcome in response to identifying the transport packet as containing audio stream data as recited by claims 1 and 32.

Rim and the ITU-T Reference Fail to Disclose or Suggest Enabling Audio Stream Data or Discarding the Transport Packet Based on the First Outcome

Claim 1 further recites the limitations of determining whether to enable audio stream data related to the transport packet to be received by a system or to discard the transport packet based at least in part on the first outcome (where the first outcome is determined by the comparing of the value of the first field in the transport packet to a value of a first field register as described above). Claim 32 recites similar limitations. The Examiner acknowledges that Rim fails to

disclose or suggest these limitations, so the Examiner instead asserts that the ITU-T reference teaches these limitations. Specifically, the Examiner relies on the passage of the ITU-T reference at pages 19-20, which discloses that "ITU-T Rec. H.222.0|ISO/IEC 13818-1 decoders shall discard Transport Stream packets with the adaptation_field_control field set to a value of '00'. In the case of a null packet the value of the adaptation_field_control shall be set to '01'." Table 2-5 at page 19 of the ITU-T reference discloses that the values of the adaptation_field_control field indicate "Reserved for future use by ISO/IEC"; "No adaptation_field, payload only"; "Adaptation_field only, no payload"; or "Adaptation_field followed by payload". Thus, it appears from the Examiner's remarks that the Examiner considers that the comparison of the adaptation_field_control field to the value '00' to determine whether to discard Transport Stream packets is the same or equivalent to the limitations of determining whether to enable audio stream data to be received by a system or to discard the transport packet based on the first outcome as recited by claims 1 and 32. However, as noted above, the first outcome is determined by a comparison that is in response to identifying the transport packet as containing audio stream data. As noted above, Rim fails to disclose identifying a transport packet as containing audio stream data and therefore fails to disclose comparing a value of a first field of the transport packet to determine the first outcome in response to such identification. Likewise, the ITU-T reference fails to disclose or suggest performing such a comparison in response to identifying the transport packet as containing audio data. Consequently, Rim and the ITU-T reference, if proposed as combined, necessarily fail to disclose or suggest the limitations of determining whether to enable audio stream data to be received or to discard the transport packet based at least in part on the first outcome for at least the reason that the first outcome is determined by a comparison that is in response to identifying the transport packet as containing audio stream data.

Rim and the ITU-T Reference Fail to Disclose or Suggest a Transport Packet Parser Having a First Comparator and an Audio Parser Having a Second Comparator

Claim 15, from which claims 16-19, 22, 23 and 29 depend, has been amended to clarify the claimed subject matter. Claim 15 recites the limitations of a transport packet parser having a first comparator having a first input coupled to the output of a storage location and an output coupled to an audio parser. Claim 15 further recites the limitations of an audio parser having a second comparator having an input coupled to the output of a first storage location of the audio

PATENT

parser and an output. With respect to the first comparator of the transport packet parser, the Examiner asserts that the "output of parser 11 is connected to CPU Interface Unit 14 as shown in figures 3 and 4. The CPU Interface Unit 14 of figures 3-4 performs the comparison process described in col. 7, line 45 to col. 8, lines 10 [sic]." *Office Action*, p. 4. With respect to the second comparator of the audio parser, the Examiner again asserts that the "output of parser 11 is connected to CPU Interface Unit 14 as shown in figures 3 and 4. The CPU Interface Unit 14 of figures 3-4 performs the comparison process described in col. 7, line 45 to col. 8, lines 10). *Id.* Thus, the Examiner relies on the same "comparison process" described at col. 7, line 45 –col. 8, line 10 of Rim to disclose both a transport packet parser having a first comparator and an audio parser having a second comparator. However, not only does the cited passage of Rim fail to disclose or suggest a transport packet parser having a comparator or an audio parser having a comparator, the cited passage of Rim fails to disclose or suggest that the "comparison processes" is performed by a transport packet parser or an audio parser. Instead, as acknowledged by the Examiner, the alleged "comparison process" is performed by the CPU Interface Unit 14, which is not described by Rim as being either a transport packet parser or an audio parser or performing the functions of a transport packet parser or an audio parser. *See Id.* Moreover, assuming that the "comparison process" of the cited passage of Rim was equivalent to a comparator, Rim discloses only one "comparison process," whereas claim 15 recites two comparators, one comparator at the transport packet parser and one comparator at the audio parser. Accordingly, Rim fails to disclose or suggest the limitations of a transport packet parser having a first comparator and an audio parser having a second comparator as recited by claim 15.

Rim and the ITU-T Reference Fail to Disclose or Suggest an Audio Decoding System Enabled to Process Audio Data or to Discard Audio Data based on an Output of a Comparator of an Audio Parser

Claim 15 further recites the limitations of wherein an audio decoding system is enabled to process audio data or to discard audio data based at least in part on the output of the second comparator of the audio parser. As acknowledged by the Examiner, Rim fails to disclose or suggest these limitations. *See Office Action*, p. 5. The Examiner therefore relies on the ITU-T reference as disclosing these limitations. Specifically, the Examiner asserts that pages 19-20 of the ITU-T reference "teaches that the audio decoding system is enabled to process the audio data or to discard the audio data . . . based at least in part on the output of the [second] comparator." *Id.* However, as noted above, the ITU-T reference teaches discarding a transport packet if its

PATENT

adaptation_field_control field has a value of '00'. It will be appreciated that the decision on whether to discard or keep a transport packet conventionally occurs at a transport packet parser and does not occur at an audio parser and Rim and the ITU-T reference provide no disclosure inconsistent with this convention. Thus, Rim and the ITU-T reference fail to disclose or suggest, alone or in combination, that an audio decoding system is enabled to process audio data or to discard audio data *based at least in part on the output of the second comparator of the audio parser* as recited by claim 15.

The Proposed Combination of Rim and the ITU-T Reference Fails to Disclose or Suggest Each and Every Limitation of Claims 1-5, 7-9, 11-19, 22, 23, 29, 31 and 32

As noted above, Rim and the ITU-T reference fail to disclose or suggest, alone or in combination, at least one limitation of each of claims 1, 15 and 32. Accordingly, the Office Action fails to establish that the proposed combination of Rim and the ITU-T reference discloses or suggest each and every limitation of claims 1, 15 and 32, as well as each and every limitation of claims 2-5, 7-9, 11-14, 16-19, 22, 23, 29 and 31 at least by virtue of their dependency from one of claims 1 or 15. Moreover, the dependent claims recite additional limitations neither disclosed nor suggested by the cited references.

In view of the foregoing, it is respectfully submitted that the obviousness rejection of claims 1-5, 7-9, 11-19, 22, 23, 29, 31 and 32 is improper and the withdrawal of this rejection therefore is respectfully requested.

Obviousness Rejection of Claims 6, 10, 21 and 24-28

At page 8 of the Office Action, claim 6 was rejected under 35 U.S.C. Section 103(a) as being unpatentable over Rim in view of the ITU-T reference and further in view of Takahashi (U.S. Patent No. 6,449,352). At page 9 of the Office Action, claims 10 and 21 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Rim in view of the ITU-T reference and further in view of Van Steenbrugge (U.S. Patent No. 6,076,062 and claims 24, 25, 27 and 28 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Rim in view of the ITU-T reference and further in view of Graham-Cumming (U.S. Patent No. 6,076,062). At page 11 of the Office Action, claim 26 was rejected under 35 U.S.C. Section 103(a) as being unpatentable over Rim in view of the ITU-T reference and Graham-Cumming and further in view of Takahashi. These rejections are respectfully traversed.

PATENT

Claims 6 and 10 depend from claim 1. Claims 21 and 24-28 depend from claim 15. As noted above, the combination of Rim and the ITU-T reference fails to disclose or suggest numerous limitations of claims 1 and 15. The Examiner does not assert that any of Takahashi, Van Steenbrugge or Graham-Cumming discloses or suggests any of these limitations nor is any disclosure directed to any of these limitations to be found in these references. Accordingly, the Office Action fails to establish that the proposed combinations of Rim, the ITU-T reference, Takahashi, Van Steenbrugge and Graham-Cumming disclose or suggest each and every limitation of claims 1 and 15, as well as each and every limitation of claims 6, 10, 21 and 24-28 at least by virtue of their dependency from one of claims 1 or 15. Moreover, these claims recite additional limitations neither disclosed nor suggested by the cited references.


In view of the foregoing, it is respectfully submitted that the obviousness rejections of claims 6, 10, 21 and 24-28 are improper and the withdrawal of these rejections therefore is respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-0441.

Respectfully submitted,

3 May 2005
Date


Ryan S. Davidson, Reg. No. 51,596,
TOLER, LARSON & ABEL, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone) (512) 327-5452 (fax)